

Application No.: 10/694,690
Amendment dated: August 22, 2005
Reply to Office Action of April 20, 2005
Attorney Docket No.: 21295.68 (H5745US)

b.) Remarks

Claims 1-20 are pending in this application. Claims 1, 6, 8, 13 and 20 have been amended in various particulars as indicated hereinabove.

Turning first to the Office Action Summary Sheet, claims 1-20 are pending in the application. Claims 1-20 were rejected.

Turning now to the merits, Claims 5, 8-11 and 20 were objected to because of informalities. Amendments to Claim 1, 8 and 20 overcome those informalities.

1. Claims 1, 4, 5 and 8-11 were rejected under 35 U.S.C. 102(b) as being anticipated by Garner (US 5,557,456). This rejection is respectfully traversed for the following reasons.

It is well established that a claim is anticipated under 35 U.S.C. §102, only if each and every element of the claim is found in a single prior art reference.¹ Moreover, to anticipate a claim under 35 U.S.C. §102, a single source must contain each and every element of the claim "arranged as in the claim."^{2,3} Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference.⁴ If each and every element of a claim is not found in a single reference, there can be no anticipation.

Independent Claim 1 has been amended to more particularly point out that the claimed comparison optical system comprises several image acquiring optical subsystems, each of which is associated with its own respective motorized XYZ stage. A control unit is provided for accomplishing synchronous movement of all motorized XYZ stages in all three spatial directions (X, Y, and Z directions).

¹ *Veregal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987).

² *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

³ *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q. 2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988).

⁴ *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

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The Patent Office has stated that Garner discloses two image acquiring systems 1 and 7. Upon closer examination of Garner it follows that Roman numeral 7 is a sensor associated with an image sensor controller (Col. 3, lines 44-46), and not an optical subsystem. Also, since there is only one optical subsystem (a microscope 1) in Garner, no bridge connecting several (or at least two) optical subsystems could be found in Garner. Moreover, no respective synchronized motorized XYZ stages, each of the stages being associated with its respective optical subsystem, could be found in Garner, contrary to what is claimed in amended independent Claim 1. Since each and every element as in Claim 1 could not be found in Garner, the rejection should be withdrawn and Claim 1 should be allowed.

Claims 2-4 depend off independent allowable Claim 1 and are now allowable.

2. Claims 2, 6 and 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Garner in view of Reichel (US 4,403,839). This rejection is respectfully traversed for the following reasons.

For an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case of obviousness. The Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the cited publications, which must have a suggestion, teaching or motivation for one of ordinary skill in the art to modify a reference or combined references.⁵ The cited publications should explicitly provide a reasonable expectation of success, determined from the position of one of ordinary skill in the art at the time the invention was made.⁶

The Patent Office stated that "Garner teaches the invention as claimed but lacks reference to the use of macrosopes." With regard to independent Claim 1, similarly to what has already been presented above, Garner discloses a sensor 7 associated with an image sensor controller (Col. 3, lines 44-46), and not any optical subsystem. Also, since

⁵ *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

⁶ *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970);

Amgen v. Chugai Pharmaceuticals Co., 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996);

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there is only one optical subsystem (a microscope 1) in Garner, no bridge connecting two microscopes could be found in Garner. Moreover, no respective synchronized motorized XYZ stages, each of the stages being associated with its respective optical subsystem (microscope), could be found in Garner, contrary to what is claimed in amended independent Claim 6. Reicher does not disclose anything about the synchronized spatial motion of the XYZ stages associated with their respective microscopes. Therefore, the combination of Garner and Reichel does not disclose each and every element of the invention as claimed in independent Claim 6. Therefore, the obviousness rejection should be withdrawn and Claim 6 should be allowed.

Claim 7 depends off now allowable Claim 6 and should be allowed. Claim 2 depends off now allowable Claim 1 and should be allowed.

3. Claims 3 and 12-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Garner. This rejection is respectfully traversed for the following reasons.

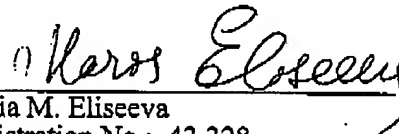
With regard to independent Claim 13 similarly to what has already been presented above, Garner discloses a sensor 7 associated with an image sensor controller (Col. 3, lines 44-46), and not any optical subsystem. Also, since there is only one optical subsystem (a microscope 1) in Garner, no bridge connecting two microscopes could be found in Garner. Moreover, no respective synchronized motorized XYZ stages, each of the stages being associated with its respective optical subsystem (microscope), could be found in Garner, contrary to what is claimed in amended independent Claim 13. Therefore, Garner does not disclose each and every element of the invention as claimed in independent Claim 13. Therefore, the obviousness rejection should be withdrawn and Claim 13 should be allowed.

Claims 14-20 depend off now allowable Claim 13 and should be allowed. Claim 3 depends off now allowable Claim 1 and should be allowed. Claim 12 depends off now allowable Claim 6 and should be allowed.

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Applicants believe that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,
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